

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: T. OGAWA et al.	)	Confirmation No.: 1486
	)	
Application No.: 10/564,761	)	Art Unit: 3721
	)	
Filed: January 17, 2006	)	Examiner: L. Low
	)	
For: CYLINDRICAL CONTACT ARM	)	
HAVING TAPERED GUIDE SECTION	)	
IN A POWER-DRIVEN	)	
NAILING MACHINE (As Amended)	)	

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**APPEAL BRIEF**

This brief is in furtherance of the Notice of Appeal, filed in the above-identified patent application on October 8, 2009. The fee set forth under 37 C.F.R. § 41.20(b)(2) is being filed concurrently herewith. The period for filing this brief extends through December 8, 2009.

**1. Real Party In Interest**

The real party in interest is Max Co., Ltd. of Tokyo, Japan ("Max Co.").

**2. Related Appeals and Interferences**

There are no related appeals and interferences.

3. **Status of Claims**

Claims 1 and 3-21 stand rejected.

Claim 2 has been canceled.

Claims 1 and 3-21 are the subject of this appeal.

4. **Status of Amendments**

No amendment was filed subsequent to the final rejection.

5. **Summary of Claimed Subject Matter**

Applicants' invention is directed to a power-driven nailing machine which deters driver mark damage and the driving of slanted nails. The power-driven nailing machine comprises a driver, a nail supply, a nose body proximate the driver and the nail supply, and a contact nose which is disposed on the nose body and which is configured to maintain contact with a work piece while aligning the head and shaft of the nail before it is discharged from the machine. Applicants' invention averts driver mark damage and discourages the nail from being driven into the work piece in a slanted status despite the reaction of the nailing machine and the resulting formation of a space between the discharge port of the nose body and the nail guide mechanism of the contact nose.

Referring to FIG. 1 of applicants drawing sheets, a preferred embodiment of the power-driven nailing machine comprises a driving piston 4 integrally coupled with a driver 5 for striking a nail, and a nose body 6 comprising a hollow discharge port 7. Specification, 7:21-23. The driving piston 4 is projected so that the driver 5 is accommodated in the discharge port 7 of the nose body 6. *Id.* at 7:26 to 8:3. A nail supply guide 9 supplies a nail from a magazine 8 to the discharge port 7. *Id.* at 8:4-5. At the leading end side of the nose body 6, a hollow contact nose 13 having a leading end discharge port 12 continuous to the discharge port 7 of the nose body 6 is formed. *Id.* at 8:22-24.

*At the upper portion of the contact nose 13, a cylindrical area 13a with a larger diameter is formed.* (Emphasis added). *Id.* at 8:24-26. By accommodating the lower end of the nose body 6 in the cylindrical area 13a, the contact nose 13 is held slidably along the discharge port 7 of the nose body 6. *Id.* at 8:26 to 9:3. Furthermore, the contact nose 13 comprises a leading end discharge port 12 for guiding the nail toward the face of the work. *Id.* at 9:15-17. The leading end discharge port 12 comprises a straight guide portion 17. *Id.* at 9:17-20. The straight guide portion has a slightly larger inner diameter than that of the head H of the nail N. *Id.* The length of the straight guide portion 17 is longer than a maximum sized nail which can be used in the nailing machine. *Id.* at 10:5-8. The contact nose 13 also comprises a tapered guide face 18 between the straight guide portion 17 and the larger cylindrical area 13a. *Id.* 9:25 to 10:4.

Moreover, the contact nose 13 is coupled with the lower end of a contact arm 16. *Id.* at 9:5-8. The upper end of the contact arm 16 is located near the trigger lever 14. *Id.* The contact arm 16 biases the contact nose 13 toward the leading end of the nose body 6. *Id.* at 9:8-10.

The nailing machine of FIG 1 is actuated by bringing the contact nose 13 into contact with the face of the work so that the contact nose 13 is slid to the nose body 6 and then operating the trigger lever 14 formed at the base of the grip 2. *Id.* at 9:10-14. *See also, Id.* at 11:3-6. The activated driver 5 then knocks the nail N into the leading end discharge port 12 of the contact nose 13. *Id.* at 11:6-14. As shown in FIG. 4, the leading end P and head H pass through the straight guide portion 17 such that the nail N is aligned or held in a vertical status. *Id.* at 12:1-7. *See also, Id.* at 10:12-18. The nail is subsequently driven out from the leading end discharge port 12. *Id.* Accordingly, the nail N is aligned or held in a vertical status by the straight guide portion 17 even where a gap is created between the tapered guide face 18 of contact nose 13 and the discharge port 7 of nose body 6. *Id.* at 12:8-25.

#### Claim 1

Claim 1 recites a power driven nailing machine comprising, in part, a nose body and a contact nose. *See e.g.,* Specification, 7:21-23 and 8:22-24; FIG. 1. The recited contact nose is arranged to be protrusively urged toward a leading end of the nose body. *Id.* at 9:5-10. The

recited contact nose comprises a cylindrical portion formed at its upper portion such that the cylindrical portion defines a circular cylindrical bore. *Id.* at 8:24-26. The recited cylindrical portion defines a circular cylindrical bore which comprises a longitudinal axis and a substantially uniform cross section transverse to the longitudinal axis. *See e.g.*, FIG 2. The recited circular cylindrical bore extends from an interior of the contact nose to an upper end surface of the upper end of the contact nose. *Id.* The recited upper end surface is substantially transverse to the longitudinal axis of the circular cylindrical bore. *Id.* The recited nose body is housed in the circular cylindrical bore such that the contact nose is held slidably along the nail discharge port of the nose body. *Id.* at 8:26 to 9:3; FIG. 2. The recited contact nose includes a leading end discharge port for guiding a nail driven from the leading end discharge port toward a work. *Id.* at 12:1-7; FIG. 4. The recited leading end discharge port includes a guide portion longer than the nail. *Id.* at 10:12-18.

Claim 8

Claim 8 recites a power-driven nailing machine comprising, in part, a driving cylinder, a driver, a nose body, a contact nose, and a nail supply mechanism. Specification at 7:17 to 8:8 and 8:22-24; FIG. 1. The recited nose body has third and fourth ends proximate the driving cylinder. FIG. 1. The third end of the nose body is disposed between the driving cylinder and the fourth end of the nose body. *Id.* The recited nail supply mechanism is disposed between the driving cylinder and the fourth end of the nose body. Specification at 8:5-8; FIG. 1.

The recited contact nose comprises a hollow member with proximal and distal ends, which defines inner and outer surfaces extending from the proximal end to the distal end. *Id.* at 8:22-26. The recited fourth end of the nose body is circumferentially received within the proximal end of the hollow member such that the nose body is slidable relative to the hollow member between third and fourth positions. *Id.* at 8:26 to 9:3; FIG. 4; FIG. 3.

The recited fourth end of the nose body rests on a first portion of the inner surface at the fourth position (FIG. 3) and is spaced from the first portion of the inner surface at the third position (FIG. 4). The recited inner surface further including a guide portion disposed between

the fourth position and the distal end. Specification at 8:22-24; FIG. 4. The recited guide portion is configured and dimensioned to form a radial enclosure about the at least one-sized nail such that the radial enclosure aligns the at least one-sized nail with the longitudinal axis of the driving cylinder before the driver pushes the at least one-sized nail out the leading end of the contact nose into the work piece. *Id.* at 9:15 to 10:18 and 12:1-25; FIG. 4.

The recited nail supply mechanism is disposed between the driving cylinder and the fourth end of the nose body. FIG. 1 The recited nail supply mechanism supplies the at least one-sized nail to the nose body and is configured and dimensioned to accommodate only nails having a length less than or equal to the distance measured along the longitudinal axis from the leading end of the contact nose to a farthest extent of the radial enclosure. Specification at 10:5-8.

Claim 17

Claim 17 depends from claim 8 and recites that the proximal end of the hollow member comprises a first circular cylindrical bore defined by the inner surface. Specification at 8:24-26. Further, claim 17 recites that fourth end of the nose body is circumferentially received within the first circular cylindrical bore. *Id.* at 8:26 to 9:3.

**6. Grounds of Rejection to be Reviewed on Appeal**

In the Office Action dated July 8, 2009:

- Claims 1 and 3-7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite; and
- Claims 1 and 3-21 were rejected under 35 U.S.C. §102 as anticipated by JP-A-2002-337066 (which corresponds to U.S. Patent No. 6,578,750).

**7. Argument**

Appellant respectfully asserts that the rejections under 35 U.S.C. § 112 and 35 U.S.C. § 102 are improper and should be reversed.

**A. Claims 1 and 3-7 Are Not Indefinite**

Claim 1 and 3-7 meet the requirement for definiteness of 35 U.S.C. §112, second paragraph. The MPEP at §2173.02 (“Clarity and Precision”) states that the “focus during the examination of claims for compliance with the requirement for definiteness of 35 U.S.C. §112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” *In re Skvorecz*, 92 USPQ2d 1020, 1025 (Fed. Cir. 2009). The MPEP states:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of:  
(A) The content of the particular application disclosure;  
(B) The teachings of prior art; and  
(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

Moreover, MPEP §2173.02 states: “Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.” *Id.*

**Independent claim 1**

Claim 1 satisfies the statutory requirements of 35 U.S.C. 112 ¶2. More particularly, claim 1 as a whole, when read in light of the drawings and specification, apprises a person of ordinary skill in the art of the metes and bounds of the claim.

First, the specification describes an exemplary contact nose as follows:

At the leading end side of the nose body 6, a hollow contact nose 13, having a leading end discharge port 12 continuous to the discharge port 7 of the nose body 6 is formed. At the upper portion of the contact nose 13 a cylindrical area 13a with a larger diameter is formed. By accommodating the lower end of the nose body 6 in the cylindrical area 13a, the contact nose is held slidably along the discharge port 7 of the nose body. Specification, p. 8, line: 22 to p. 9, line: 3.

Second, the drawings, such as FIG. 2 depict an exemplary contact nose, which comprises cylindrical area 13a that extends from an interior of the contact nose to its upper end. *Id.*

Third, the text of claim 1 particularly points out and distinctly claims features of the recited “contact nose.” In relevant part, claim 1 recites:

“[a] contact nose having an upper end and a leading end, including a cylindrical portion formed at its upper portion such that the cylindrical portion defines a circular cylindrical bore having a longitudinal axis and a substantially uniform cross section transverse to the longitudinal axis, the circular cylindrical bore extending from an interior of the contact nose to an upper end surface substantially transverse to the longitudinal axis of the upper end.”

The antecedent basis for the term “upper end” appears in the phrase “the contact nose having an upper end.” The antecedent basis for “longitudinal axis” appears in the phrase “a circular cylindrical bore having a longitudinal axis.”

Hence, claim 1 as a whole, when read in light of the drawings and specification describes a contact nose which comprises a cylindrical portion that defines a “circular cylindrical bore.” The recited circular cylindrical bore has a longitudinal axis and extends from an interior of the contact nose to an upper end surface of the upper end of the contact nose. In addition, the recited upper end surface is substantially transverse to the longitudinal axis of the bore.

Consequently, claim 1 meets the threshold requirements of clarity and precision, and thus is not indefinite.

Dependent claims 3-7

Dependent claims 3-7 are not indefinite for the same reason claim 1 is not indefinite.

**B. Claims 1 and 3-21 Are Not Anticipated**

In the Office Action dated July 8, 2009, the examiner rejected claim 1 as anticipated by JP-A-2002-337066. The examiner determined that certain elements of claims 1 and 3-21 were disclosed by figures from U.S. Patent No. 6,578,750 to Kubo et al. (“Kubo et al.”) which claims priority to JP-A-2002-337066.

Independent claim 1

Claim 1 principally stands rejected based on paragraph 3 of the Office Action dated December 24, 2008. According to the examiner’s rejection, nose top 36 and contact top 37 of

Kubo et al. disclose all the limitations of the “contact nose” recited by claim 1. More particularly, the rejection relies upon marked-up FIG. 6 (Exhibit 1) on page 3 of the December 24, 2008 Office Action to identify certain alleged limitations of the recited contact nose.

Referring to marked up FIG. 6 (Exhibit 1), portion 45 and portion 37 do not define a circular cylindrical bore. The tapered bore at the proximal end of portion 36, likewise, does not define a circular cylindrical bore. Nor does the alleged “circular cylindrical bore” have a substantially uniform cross section transverse to its longitudinal axis. Instead, the alleged contact nose 37 defines an interior space having non-circular cross-sectional shape.

Moreover, FIG. 5 of Kubo et al. (Exhibit 2) discloses a cross section of contact top 37. As shown in FIG. 5 of Kubo et al., the inner surface of contact top 37 includes a pair of guide grooves 43 and an escape opening 45.

Accordingly, contact top 37 of Kubo et al defines a generally C-shaped passage with opposing rectangular guide grooves, but fails to disclose the “circular cylindrical bore” recited by claim 1. Thus, FIG. 6 of Kubo et al. does not disclose a “contact nose” as recited by claim 1, and hence marked-up FIG. 6 cannot anticipate claim 1.

Applicants further submit that the alleged “upper end” as construed by the Examiner is an unduly broad interpretation of the term “upper end.” Construing the top half of the alleged contact nose as the “upper end” is simply not credible nor justified in light of the specification, and thus is not reasonable. *See e.g.*, FIG. 2, Specification, p. 8:22 to 9:3. *See also*, MPEP 2111.

#### Dependent Claims 3-7

Dependent claims 3-7 are not anticipated for the same reason claim 1 is not anticipated.

#### Independent Claim 8

Claim 8 ultimately stands rejected based on paragraph 9 of the Office Action dated March 26, 2007. According to the examiner’s rejection, nose top 36 and contact top 37 of Kubo et al. disclose all the limitations of the “contact nose” recited by claim 8. More particularly, the examiner stated:

Contact nose (36) includes a hollow member (45) that has proximal and distal ends (FIG. 1), inner and outer surfaces and is slidable relative to the nose body



(26).” A guide portion (36) forms a radial enclosure aligned with at least one nail.” Office Action dated March 26, 2007, p. 4 lines 9-11.

Additionally, in paragraph 5 of the Office Action dated July 8, 2009, the examiner stated:

Applicant contends that the prior art’s nose body is not circumferentially received in the hollow member. However referring to the figure reproduced above [marked up FIG. 6 of Kubo], the nose body is received in the hollow member. Note that a portion of the hollow member where the nose body is received has a circumference. In other words, that the portion of the hollow member surrounds the nose body. Office Action dated July 8, 2009, paragraph 5.

By contrast, claim 8 recites, in part, that “the nose body [is] circumferentially received within the *proximal end* of the hollow member such that the nose body is slidable relative to the hollow member between third and fourth positions.” As described in connection with claim 1, Kubo et al. discloses a contact top 37 having an upper portion with a generally “C” shaped cross section due to escape portion 45. Kubo et al. fails to disclose a “nose body [that is] circumferentially received within the *proximal end* of the hollow member” because the *proximal end* of the alleged hollow member 45 does not surround the alleged nose body 26. Thus, Kubo et al. cannot anticipate claim 8.

#### Dependent claims 9-16

Dependent claims 9-16 are not anticipated for the same reasons claim 8 is not anticipated.

#### Dependent claim 17

Dependent claims 17 is not anticipated for the same reason claim 8 is not anticipated. Moreover, the standing rejection of claim 17 is flawed because it ignores the term “first circular cylindrical bore.”

In the pending Office Action, the examiner rejected claim 17 as anticipated based on a second marked up figure from page 3 of the Office Action dated December 24, 2008 (Exhibit 1).

Referring to the second marked up figure (Exhibit 1), neither the alleged hollow member depicted in the second marked up figure from the Office Action dated December 24, 2008 nor the alleged hollow member 45 from the Office Action dated March 26, 2007 show a circular cylindrical bore at the proximal end of the hollow member. Instead, the proximal end of the

alleged hollow member includes spaces having non-circular and non-uniform cross-sections transverse to the longitudinal axis of the alleged hollow member. Moreover, the alleged nose body is not "circumferentially received" within the alleged first circular cylindrical bore.

Thus, the Examiner's pending rejection based on 35 U.S.C. 102(b) fails to disclose a "contact nose" as recited by claim 17.

Dependent claims 18-20

Dependent claims 18-20 are not anticipated for the same reasons as claim 17 is not anticipated.

Dependent claims 21

Dependent claim 21 is not anticipated for the same reason as claim 8 is not anticipated.

\*\*\*\*

In view of the foregoing, Appellant respectfully requests the reversal of the Examiner's rejection and allowance of the pending claims. If there are any other fees due in connection with the filing of this Appeal Brief, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account No. 50-0310.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: November 30, 2009

By: 

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8. Claims Appendix

1. (Previously presented) A power-driven nailing machine comprising:

a driving cylinder;

a driving piston slidably housed within the driving cylinder;

a driver coupled with the driving piston;

a nose body having a lower end with a nail discharge port; and

a contact nose arranged to be protrusively urged toward a leading end of the nose body, the contact nose having an upper end and a leading end, including a cylindrical portion formed at its upper portion such that the cylindrical portion defines a circular cylindrical bore having a longitudinal axis and a substantially uniform cross section transverse to the longitudinal axis, the circular cylindrical bore extending from an interior of the contact nose to an upper end surface substantially transverse to the longitudinal axis of the upper end, the nose body being housed in the circular cylindrical bore such that the contact nose is held slidably along the nail discharge port of the nose body,

wherein the contact nose includes a leading end discharge port for guiding a nail driven from the leading end discharge port toward a work, and the leading end discharge port includes a guide portion longer than the nail.

2. Canceled.

3. (Previously presented) The power-driven nailing machine according to claim 1, wherein the guide portion includes:

a straight guide portion formed at a leading end side of the leading end discharge port; and

a tapered guide face formed above the straight guide portion and having an inner diameter gradually increasing upward, and

when a leading end of the nail is driven into the work, the leading end of the nail and the head of the nail is positioned within the straight guide portion.

4. (Original) The power-driven nailing machine according to claim 1, wherein the guide portion includes:

a first tapered guide portion formed at a leading end side of the leading end discharge port; and

a second tapered guide portion formed above the first tapered segment and having an inner diameter gradually increasing upward, and

wherein the first tapered guide portion is tapered with an inner diameter increasing from the leading end toward second tapered guide portion.

5. (Previously Presented) The power-driven nailing machine of claim 1, further comprising a trigger for activating the driving piston.

6. (Previously Presented) The power-driven nailing machine of claim 5, wherein the contact nose is movable relative to the nose body such that in one configuration the nose body blocks movement of the contact nose so that the trigger is actuated.

7. (Previously Presented) The power-driven nailing machine of claim 1, wherein the driving piston is driven by compressed air.

8. (Previously presented) A power-driven nailing machine adapted to drive at least one-sized nail into a work piece comprising:

a driving cylinder with a longitudinal axis, including

a driving piston operable between first and second positions, the second position being spaced from the first position along the longitudinal axis, and

a driver having first and second ends, the first end being connected to the driving piston, the second end having a first outer dimension transverse to the longitudinal axis;

a nose body having third and fourth ends proximate the driving cylinder, the third end of the nose body being disposed between the driving cylinder and the fourth end of the nose body, the nose body including a first passage extending from the third end to the fourth end, the passage defining a first inner dimension transverse to the longitudinal axis of the driving cylinder, the first inner dimension being greater than the first outer dimension;

a contact nose having a leading end, the contact nose including a hollow member with proximal and distal ends, the hollow member defining inner and outer surfaces extending from the proximal end to the distal end, the fourth end of the nose body being circumferentially received within the proximal end of the hollow member such that the nose body is slidable relative to the hollow member between third and fourth positions, the fourth end resting on a first portion of the inner surface at the fourth position and being spaced from the first portion of the inner surface at the third position, the inner surface further including a guide portion disposed between the fourth position and the distal end, the guide portion being configured and dimensioned to form a radial enclosure about the at least one-sized nail such that the radial enclosure aligns the at least one-sized nail with the longitudinal axis of the driving cylinder before the driver pushes the at least one-sized nail out the leading end of the contact nose into the work piece; and

a nail supply mechanism disposed between the driving cylinder and the fourth end of the nose body such that the nail supply mechanism supplies the at least one-sized nail to the nose body, the nail supply mechanism being configured and dimensioned to accommodate only

nails having a length less than or equal to the distance measured along the longitudinal axis from the leading end of the contact nose to a farthest extent of the radial enclosure.

9. (Previously Presented) The power-driven nailing machine of claim 8, wherein the guide portion includes a tapered guide face.

10. (Previously Presented) The power-driven nailing machine of claim 9, wherein the radial enclosure has a straight guide portion.

11. (Previously presented) The power-driven nailing machine of claim 10, further comprising a trigger such that actuating the trigger causes the driving piston to move from the first position to the second position.

12. (Previously presented) The power-driven nailing machine of claim 11, wherein the contact nose is movable relative to the nose body such that in one configuration the nose body blocks movement of the contact nose to activate the trigger.

13. (Previously Presented) The power-driven nailing machine of claim 11, further comprising a grip connected to driving cylinder.

14. (Previously Presented) The power-driven nailing machine of claim 13, wherein the grip includes a chamber for storing compressed air.

15. (Previously Presented) The power-driven nailing machine of claim 14, wherein the driving piston is driven by compressed air from the chamber.

16. (Previously Presented) The power-driven nailing machine of claim 8, wherein the driver extends through the passage in the nose body and into the contact nose when the driving piston is in the second position.

17. (Previously presented) The power-driven nailing machine of claim 8, wherein the proximal end of the hollow member comprises a first circular cylindrical bore defined by the inner surface and the fourth end of the nose body is circumferentially received within the first circular cylindrical bore.

18. (Previously presented) The power-driven nailing machine of claim 17, wherein the first circular cylindrical bore has a first diameter and the distal end of the hollow member comprises a second circular cylindrical bore defined by the inner surface, the second circular cylindrical bore having a second diameter different than the first diameter.

19. (Previously presented) The power-driven nailing machine of claim 18, wherein the first diameter is greater than the second diameter.

20. (Previously presented) The power-driven nailing machine of claim 19, wherein the second circular cylindrical bore forms part of the guide portion.

21. (Previously presented) The power-driven nailing machine of claim 8, wherein the nose body is slidable relative to the hollow member along an axis between the third and fourth positions and the inner surface is substantially perpendicular to the axis at the fourth position.



9. Evidence Appendix

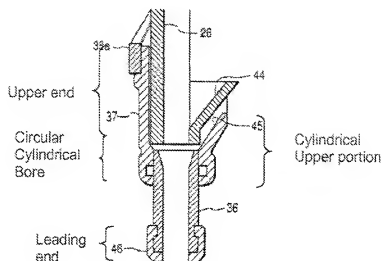
Attached are:

Page 3 of the Office Action dated December 24, 2008 (Exhibit 1)

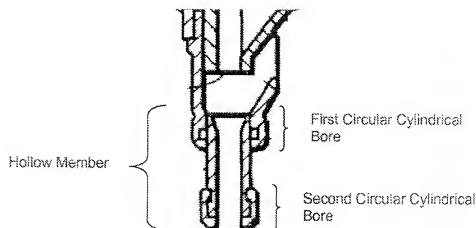
Sheet 5 of 7, U.S. Patent No. 6,578,750 to Kubo et al. (Exhibit 2)

# EXHIBIT 1

**FIG. 6**



Regarding new claims 17-20, refer to the figure below for the designations of the hollow member with its proximal and distal ends, the first circular cylindrical bore, and the second circular cylindrical bore.



## EXHIBIT 2

FIG. 5

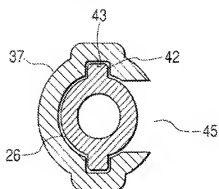
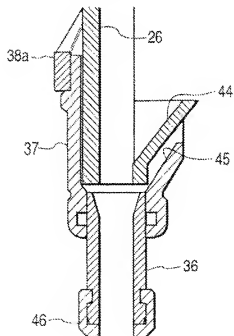


FIG. 6



10. **Related Proceedings Appendix**

None